

Application No.: 10/760,665

Docket No.: 65857-0120

**REMARKS**

Applicants have carefully reviewed the Office Action mailed May 10, 2005, and thank Examiner Lorence for his detailed review of the pending claims. In response to the Office Action, Applicants have amended claims 1, 10, 21, and 24, and canceled claims 7, 8 and 20. By way of this amendment, no new matter has been added. Accordingly, claims 1-6, 9-19, and 21-33 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

**Allowable Claims**

Applicants would like to thank the Examiner for indicating that dependent claims 20-23, which depend from independent claim 10, would be patentable if rewritten in independent form. The limitations of dependent claim 20 have been incorporated into independent claim 10. Accordingly, the allowability of independent claim 10, and dependent claims 11-19, 21-23, and 33 will not be addressed in the remarks below.

**Drawings**

The Drawings were objected to because the embodiments of Claims 32 and 33 were not specifically depicted. Accordingly, FIG. 33 has been added to illustrate an embodiment of the limitations of claims 32 and 33. Essentially, FIG. 33 is an alternative embodiment of the brake housing of FIG. 2 illustrating the brake housing, similar to FIG. 2, with a separate bearing cap, similar to the prior art bearing cap of FIG. 26,. Paragraph [0044] has been amended to include a description of the separate bearing cap and brake housing of FIG. 33.

Support for this new Figure 33 can be found, at least, in originally filed paragraph [0044], specifically noting that "brake housing 44 replaces the traditional bearing cap used to retain the front bearing seals of the transmission", and "brake housing 44 may exhibit configurations other than the configuration shown in FIGS. 1-3, particularly when clutch brake 30 does not need to function as a bearing cap." Support for Figure 33 can also be found in FIG. 26, mentioned in paragraph [0051], which illustrates a prior art bearing cap without a brake housing. Therefore, adequate support for the bearing cap of FIG. 26 and the brake housing 44 combined as mentioned in paragraph [0044] to illustrate the bearing cap 450 of FIG. 33.

Application No.: 10/760,665

Docket No.: 65857-0120

### Specification

Paragraph [0044] has been amended to include a description of the separate bearing cap and brake housing of newly added FIG. 33. Support for this description can be found in FIG. 26 which illustrates a prior art bearing cap, and paragraph [0044] which mentions that the brake housing may be separate from the bearing cap. Additionally, a paragraph has been added to the Brief Description of the Drawings to introduce the view of FIG. 33.

The disclosure was objected to because slots 83 were characterized as "radial slots" in paragraph [0050]. Accordingly, the term 'radial slots 83' has been changed to 'circumferentially extending arcuate slots 83,' as suggested by the Examiner.

The Examiner also suggests that 'bolts 258' should be changed to 'bolts 358' in paragraph [0053]. Accordingly, this change has been made.

### Claim Rejections – 35 U.S.C. § 112

Claims 1-33 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the independent claims appeared to the Examiner to incorrectly state the relationship between the source of magnetic flux and the through hole. Accordingly, independent claims 1, 10, and 24 have been amended to clarify the relationship between the source of magnetic flux and the through hole.

Independent claims 1 and 10 have also been amended to distinctly claim that the clutch housing and brake housing do not move relative each other in an axial direction.

### Claim Rejections – 35 U.S.C. § 102

Claims 1-6, 9-15, 18, 19, 24-29, 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Davis et al.* (EP 0822354 A2). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention

Application No.: 10/760,665

Docket No.: 65857-0120

must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 has been amended to include the limitation that "the armature includes a number of slots positioned to separate lines of magnetic flux generated by a first source of magnetic flux from lines of magnetic flux generated by a second source of magnetic flux." In contrast, Davis does not teach or suggest this limitation. Importantly, Davis illustrates only a single source of magnetic flux. Therefore, Davis cannot teach every limitation of independent claim 1.

Amended independent claim 24 positively recites that the brake housing include a "bearing seal retaining surface." In contrast, Davis makes no mention of a bearing seal, nor of a bearing seal retaining surface. Accordingly, Davis does not teach every limitation of independent claim 24.

Dependent claims 2-6, 9 and 25-32, which depend from independent claims 1 and 24, are also patentable by being dependent on an allowable base claim. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection over Davis.

Claims 1-7, 9-16, 18, 19, 24-30, 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Hsu*. (US 4,222,471). Applicants respectfully traverse the rejection.

Independent claim 1 has been amended to include the limitation from dependent claim 8 that "the armature includes a number of slots positioned to separate lines of magnetic flux generated by a first source of magnetic flux from lines of magnetic flux generated by a second source of magnetic flux." In the 35 U.S.C. § 103 rejection, the Examiner admits that *Hsu* does not contain this teaching. (Office Action dated May 10, 2005, page 5).

When referring to *Hsu*, the Examiner states that "the housing functions as a cap for bearing 61." Independent claim 24 has been amended to clarify that the combination brake and bearing cap includes "a brake housing adapted to secure a component of a bearing *seal*, the brake housing including a bearing seal retaining surface." (*Emphasis added*). *Hsu* does not teach a housing that functions to "a component of a bearing seal," as positively recited in independent claim 24.

Application No.: 10/760,665

Docket No.: 65857-0120

Furthermore, independent claim 24 has been amended to include the limitation that the bearing housing include "a bearing seal retaining surface." Hsu makes no mention of this limitation. Thus, Hsu does not teach every limitation of independent claim 1, as required in *Verdegaal Bros.*

Dependent claims 2-7, 9, 25-30, and 32, which depend from independent claims 1 and 24, are also individually patentable by being dependent on an allowable base claim. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection.

#### Claim Rejections – 35 U.S.C. § 103

Claims 8, 17 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hsu* '471 in view of *Sakurai et al.* '274 (US 5,931,274). Applicants respectfully traverse the rejection.

#### **Claim 8**

The limitations of dependent claim 8, along with the intervening limitations of dependent claim 7, have been incorporated into independent claim 1. Accordingly, the § 103(a) rejection to dependent claim 8 will be addressed as it pertains to amended independent claim 1.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants agree with the Examiner that "Hsu does not show the slots in the armature." The Examiner states that Sukurai "provides evidence that it was known at the time the invention was made to provide an armature 15 of an electromagnetic coupling device with a plurality of slots 24 in order to form a magnetic flux path." However, Sakurai teaches a single coil as a source of magnetic flux. In contrast, independent claim 1 positively recites "wherein the armature includes a number of slots positioned to separate lines of magnetic flux generated

Application No.: 10/760,665

Docket No.: 65857-0120

by a first source of magnetic flux from lines of magnetic flux generated by a second source of magnetic flux.” Therefore, Sukarai cannot teach separating lines of magnetic flux generated by different sources. Indeed, Sukarai does not mention separating lines of flux *from different sources*. Accordingly, Sukarai does not teach all the limitations of independent claim 1.

The combination of Hsu and Sukarai cannot teach an armature with slots positioned to separate lines of magnetic flux generated by different sources. No suggesting is made in either Hsu or Sukarai for the proposed combination. Importantly, Hsu teaches away from the use of slots (and therefore teaches away from the proposed combination) by mentioning, in column 2, lines 28-30, that windings are wired to minimize the inductance therebetween. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection.

#### Claim 17

Amended independent claim 10 incorporates the limitation from canceled dependent claim 20 that the assembly include “a release bearing and a release bearing actuating member adapted to move the release bearing to engage and disengage the master clutch.” In contrast, neither Hsu nor Sukarai teach this limitation. Hsu teaches an electromagnetic clutch that does not use a release bearing. Similarly, Sukarai teaches an electromagnetic clutch for a compressor that has no use for a release bearing. Accordingly, neither Hsu nor Sukarai teach every limitation of independent claim 10, as required by *In re Royka* to establish a *prima facie* of obviousness. Dependent claim 17, which depends from independent claim 10, is allowable since independent claim 10 is not obvious over the combination of Hsu and Sukarai. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

#### Claim 31

The remarks above with respect to the rejection of claim 8 are equally applicable here. Specifically the failure of the combination of Hsu and Sukarai to teach slots that separate lines of magnetic flux generated by different sources, which is a limitation of dependent claim 31. Dependent claim 31 includes the limitation that the “armature includes a number of slots positioned to separate magnetic lines of magnetic flux generated by a first source of magnetic flux from lines of magnetic flux generated by a second source of magnetic.”

Application No.: 10/760,665

Docket No.: 65857-0120

Additionally, independent claim 24 includes the limitation that the bearing housing include "a bearing seal retaining surface." Neither Hsu nor Sukarai mention this limitation. Thus, Hsu and Sukarai, alone or in combination, do not teach every limitation of independent claim 24, as required by *In re Royka* to establish a *prima facie* of obviousness. Dependent claim 31, which depends from independent claim 24, is allowable since independent claim 24 is not obvious over the combination of Hsu and Sukarai. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

### Conclusion

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 65857-0120 from which the undersigned is authorized to draw.

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Respectfully submitted,

By Kenneth W. Jarrell  
Michael B. Stewart

Registration No.: 36,018

Kenneth W. Jarrell

Registration No.: 52,484

RADER, FISHMAN &amp; GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 594-0633

Attorneys for Applicant

Attachments  
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Application No.: 10/760,665

Docket No.: 65857-0120

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes new FIG. 33.

Attachment: New sheet, FIG. 33